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10/666,538	09/19/2003	Bradley Berman	KING.005C1	5905

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EXAMINER	
HSU, RYAN	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/666,538	BERMAN ET AL.	
	Examiner	Art Unit	
	Ryan Hsu	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/12/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

In response to the amendments filed on 6/12/06, claims 1, 17, 24, 34-35 have been amended and claims 36-39 have been newly added. Claims 1-39 are pending in the current application. Examiner also notes that the amendments made to claim 17 have made it in proper dependent form and has withdrawn the objection with regard to claim 17.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-39 are rejected on the ground of nonstatutory double patenting over claims 1-55 of U. S. Patent No. 6,632,140 B2 (herein referred to as '140) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: claims 1-35 are directed towards a method and system of play in a slot game

comprising: "presenting a mechanical reel configuration comprising a plurality of active reel segments", "presenting symbols in each of the active reel segments" and deactivating the active reel segments that are associated with a discontinue symbol". Additionally, the claims of the instant application are directed towards repeating the steps described above "until a predetermined number of active reel segments have been deactivated". Claims 1-55 of U.S. patent '140 are directed towards presenting "means for presenting a display grid", "means for deactivating the active display segments that are associated with a discontinue symbol", means for awarding credits for continue symbols presented in the active display segments", and "means for repeatedly presenting symbols in each of the active display segments, awarding credits for continue symbols, and deactivating the active display segments associated with the discontinue symbols, until all of the active display segments have been deactivated". The claims of the instant application are simply a re-wording of the claimed subject matter of U.S. patent '140. The applicant's claims are simply stating the same method and system with regard to defining the stopping of reel segments based on the appearance of a continue symbol as opposed to the appearance of a discontinue symbol. One of ordinary skill in the art at the time the invention was made would realize that this method and apparatus are completing the same method and process but it is simply reworded to describe it from the discontinued symbol perspective as opposed to the continue symbol perspective.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24-28, 34, 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Mayeroff (US 6,186,894 B1).

Regarding claims 24 and 34, Mayeroff discloses a casino gaming apparatus hosting a game having at least a standard mode of operation and a bonus mode of operation, the casino gaming apparatus comprising: a video screen to present, in a play of the game, a display grid having a plurality of display cells (*see multiple pay line grid [21] of Fig. 1 and the related description thereof*); a user interface to facilitate player participation in at least the standard mode of operation (*see col. 5: ln 15-47*); and a processor configured to (i) identify a predetermined symbol combination occurring on the display grid during the standard mode of operation to activate the bonus mode of operation, in the same play of the game (*see winning pay lines, col. 1: ln 45-col. 2: ln 45, col. 7: ln 5-43*); (ii) to randomly present symbols via a physical reel configuration which includes one or more reels having corresponding reel strips (*see display [21] and display [41] of Fig. 2 and the related description thereof*); (iii) deactivate any of the reels presenting a discontinue symbol (*ie: stopped reel locations*) and (iv) repeating the random

presentation of symbols and deactivation of the reels associated with the discontinue symbols until a predetermined number of reels have been deactivated (*see col. 4: ln 29-col. 6: ln 54*).

Regarding claims 25-28, Mayeroff discloses a system wherein the processor comprises a random number generator configured to randomly select the symbols for presentation via the reels. Additionally, the system implements a user interface mechanism to allow the player to initiate each repetition of the random presentation of symbols (*see col. 1: ln 10-54*). Mayeroff also discloses a bonus payout bar to present payout subtotals for each of the reels associated with the bonus mode of operation (*see Table 2 and 3 of col. 7-8 and Fig. 1 and the related description thereof*). Furthermore, the processor is configured to automatically repeat the random presentation of symbols and deactivation of the reels associated with the discontinue symbols until all of the active display reels have been deactivated without player intervention (*see col. 4: ln 35-col. 5: ln 47*).

Regarding claim 37 and 38, Mayeroff discloses a method of operating a reel segment that is prevented from presenting another symbol in the same play of the game (*see display element [40] of Fig. 1 and the related description thereof*).

Claims 1, 35, 36 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Baerlocher et al. (US 6,319,124 B1).

Regarding claims 1 and 35, Baerlocher et al. discloses a method for facilitating a play of a slot game, comprising: (a) presenting, in the play of the slot game, a mechanical or video reel display configuration comprising a plurality of active reel segments (*see display [34] of Fig. 1 and the related description thereof*); (b) presenting symbols in each of the active reel segments

(*see 'game exhibit symbols on reels' [52] of Fig. 6 and the related description thereof*); (c) deactivating the active reel segments that are associated with a discontinue symbol (*see enhancement of losing symbols [50b] and winning symbols [50a] of Fig. 4 and the related description thereof*); and (d) repeating steps (b) and (c) in the same play of the slot game until a predetermined number of active reel segments have been deactivated (*see col. 5: ln 56-col 7: ln 43*).

Regarding claim 36 and 39, Baerlocher et al. teaches a method of operating a reel segment that are prevented from presenting another symbol in the same play of the game (*see Fig. 8-9 and the related description thereof*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al. and further in view of Telnaes (US 4,448,419).

Regarding claims 4-23, Baerlocher et al. discloses a method for facilitating a play of a slot game, comprising: (a) presenting, in the play of the slot game, a mechanical or video reel display configuration comprising a plurality of active reel segments (*see display [34] of Fig. 1 and the related description thereof*); (b) presenting symbols in each of the active reel segments

(*see 'game exhibit symbols on reels' [52] of Fig. 6 and the related description thereof*); (c) deactivating the active reel segments that are associated with a discontinue symbol (*see enhancement of losing symbols [50b] and winning symbols [50a] of Fig. 4 and the related description thereof*); and (d) repeating steps (b) and (c) in the same play of the slot game until a predetermined number of active reel segments have been deactivated (*see col. 5: ln 56-col 7: ln 43*). However, Baerlocher is not descriptive of the basic operation of the virtual reel stops.

In an analogous patent, Telnaes teaches the basic operation of a virtual reel as it is associated with a display grid or a physical reel device. Telnaes teaches a gaming machine system that allows for virtual reel stops to be activated and deactivated based on the random number readout (*see col. 4: ln 41-col. 5: ln 4*). This enables several virtual positions to be activated and deactivated resulting and affecting the physical symbol read outs and the stopping positions of the physical reels. Telnaes' also allows for repeatedly presenting symbols in each of the active reel segments and deactivating the reel segments associated with certain discontinue symbols (*ie: stopping symbols*), until a predetermined number of active reel segments have been deactivated (*ie: the system will continue to rotate through the mechanical reels until they are brought to a stop in the display grid*).

Regarding claims 4-6, Telnaes discloses a system where at least partially randomly selecting which symbol is to be presented in each of the active reel segments (*see col. 3: ln 1-17*). Additionally, Telnaes teaches a game system where the symbol is presented comprises associated a reel strip having a predetermined symbol set to each of the active reel segments (*see col. 4: ln 40-68*). Furthermore, Telnaes teaches a game system wherein associating a reel strip having a predetermined symbol set to each of the active reel segments comprises associating a

different reel strip to each of the active reel segments (*virtual reel [50] of Fig. 6 and the related description thereof*).

Regarding claims 7-8, Telnaes discloses a system wherein at least partially randomly selecting which symbol is to be presented comprises associating a predetermined symbol set to a plurality of the active reel segments (*see Fig. 6 and the related description thereof*).

Regarding claims 9-10, Telnaes discloses a method wherein at the active reel segments that are deactivated by being associated with a discontinue symbol are de-emphasized to be distinguished from the active reel segments (*see Fig. 6 and the related description thereof*).

Regarding claims 11-15, Telnaes discloses a method wherein presenting symbols in each of the active reel segments comprises presenting continue symbols in one or more of the active reel segments, wherein the continue symbols direct its respective one of the active reel segments to remain active. Additionally, the method comprises associated a credit award with one or more of the continue symbols and implementing a credit award with one or more of the continue symbols. Furthermore, the credit award may have a positive, negative or null effect on an accumulated credit total (*ie: win or lose credit award of wager lost or gained based on predetermined payout scheme*) (*see col. 4: ln 55-col. 5: ln 31*).

Regarding claims 16-19, Telnaes discloses a method comprising associating a credit award with one or more of the discontinue symbols. Where the discontinue symbols may have an additive effect a negative effect or a null effect on an accumulated credit total (*ie: win or lose credit award of wager lost or gained based on predetermined payout scheme*) (*see col. 4: ln 55-col. 5: ln 31*).

Regarding claims 20-23, Telnaes discloses a method wherein repeatedly presenting symbols comprises automatically repeating presenting symbols and deactivating the active reel segments until all of the active reel segments have been deactivated (*see reel and pay line process, col. 3: ln 42-col. 4: ln 68*). Additionally, the repeated presenting symbols comprise of providing a user interface to allow a participant to initiate each repeated presentation of symbols until all of the active reel segments have been deactivated (*see col. 3: ln 1-17*). Furthermore, the repeated presentation of symbols and deactivating the active reel segments until a predetermined number of the active reel segments have been deactivated comprises deactivating the active reel segments until all of the active reel segments have been deactivated (*see rotation of reels, col. 4: ln 19-40*).

Telnaes teaches the basic elements of a virtual reel strip. Baerlocher along with almost all modern game machines incorporate this type of virtual strip in order to offer players larger jackpots and allow for variations that mechanical mechanisms are not capable of achieving. One would be motivated to combine Telnaes with Baerlocher in order to provide a teaching of the benefits of the virtual reel strip into a game machine. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Baerlocher and Telnaes in order to provide a overview and basic operation of a virtual reel in a game machine.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al. as applied to claims above, and further in view of Inoue (US 5,722,891).

Regarding claims 2-3, Baerlocher discloses a game machine wherein presenting a mechanical reel configuration comprising a plurality of active reel segments comprises presenting the active reel segments (*see Fig. 1, 7-8 and the respective related descriptions thereof*). Baerlocher also teaches a bonus mode of play in response to presentation of a symbol combination during a standard mode of play that invokes the bonus mode of play and a bonus symbol set comprising the symbols presented in each of the active reel segments during the bonus mode of play is different than a standard symbol set comprising standard symbols presented in the reel configuration during the standard mode of play (*see Fig. 7-8 and the related description thereof*). However, Baerlocher is silent with regards to a secondary reel set. However in an analogous game machine Inoue teaches the implementation of a secondary reel set that implements a bonus mode of play where the bonus symbol set comprises symbols that are presented in active reel segments during the bonus mode of play that is different from the standard symbol set (*see bonus reels [6a, 6b, 6c] of Fig. 1 and the related description thereof*). Inoue teaches that one would be motivated to implement this feature into a game machine in order to provide a more exciting experience and also allow for an additional incentive to the player in order to increase their winnings. Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to implement the bonus game into the virtual reel system of Baerlocher to create a more exciting game machine.

Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff in view of Marnell, II et al. (US 5,332,219).

Regarding claims 29-32, Mayeroff teaches a gaming machine wherein the casino gaming apparatus comprises a slot machine and the standard mode of operation of the slot machine is a slot game (*see slot machine of Fig. 1 and the related description thereof*). However, Mayeroff is silent with regard to its implementation of a basic game including a poker game, bingo game, or keno game.

In a related patent, Marnell, II et al. teaches that it has become well known in the art that electronic gaming machines may be devised for playing games such as "roulette, keno, poker, bingo, lotto and the like" (*see col. 1: ln 13-20*). One would be motivated to implement these games to offer a wider variety of games thus attracting more players. Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to implement poker, bingo, or keno as a base game for the machine taught by Mayeroff.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff as applied to claims above, and further in view of Inoue (US 5,722,891).

Regarding claim 33, Mayeroff teaches a gaming machine wherein the random presentation of symbols and the deactivation of reels occur through the spinning and stopping of the reels (*see col. 5: ln 10-25, col. 6: ln 5-67*). However, Mayeroff is silent with regards to a processor configuring to repeat the process to randomly present the symbols and deactivation of the reels associated with the discontinue symbols until all of the reels have been deactivated. However in a related patent, Inoue teaches the use of a processor which controls the reels in order to randomly present the symbols and deactivate the reels associated with discontinue

symbols until all the reels have been deactivated (*ie: reels have come to a stop*) (*see driver [21c], and MPU [25] of Fig. 2 and the related description thereof*). The teachings of Inoue simply show how the electrical components can control the mechanical reels. One would be motivated to implement this feature in order to accurately control the movement of the reels. Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to implement the processor of Inoue into the slot machine of Mayeroff.

Response to Arguments

Applicant's arguments filed 6/12/06 have been fully considered but they are not persuasive. Applicant's representative argues with regard to claims 24-28 and 33 that Mayeroff does not show the limitations of the claim limitations. Examiner respectfully disagrees. Mayeroff as described above, is a casino gaming apparatus that comprises amongst other elements a processor and set of two reel displays. Mayeroff is split into a basic game display and a bonus game display. The processor that controls Mayeroff's invention is configured to change between a basic game and a bonus mode of operation. In the bonus mode, the system is able to activate and deactivate different reel areas. As the reels are activated they repeat a random presentation of symbols until a deactivation symbol (*ie: a random number generated that is associated with a symbol on the reel strip*) occurs in which time the reel is stopped when it comes across that symbol.

With regards to the applicant's arguments with respect to claims 29-32, Applicant contends that Mayeroff in view of Marnell does not remedy the deficiencies since Marnell is just an electronic poker game. However Examiner restates that Marnell has been combined with

Mayeroff to show the diversity in which a basic game may take form. Examiner states that Marnell is not relied upon to encompass the deficiencies that the applicant has pointed to.

With regards to applicant's arguments of claims 1-23 and 34-35, Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kaminkow et al. (US 6,514,141 B1) – Gaming Device Having Value Selection Bonus.

Webb et al. (US 6,461,241 B1) – Gaming Device Having a Primary Game Scheme Involving a Symbol-Generator and Secondary Award Triggering Games.

Hughs-Baird et al. (US 2002/0049084 A1) – Gaming Device Having An Indicator Selection with Probability-based Outcome.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Hsu whose telephone number is (571)272-7148. The examiner can normally be reached on 9 :00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (571)272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RH

SCOTT JONES
PRIMARY EXAMINER

8/20/06